

## **REMARKS**

### ***Changes to Claims***

Claims 14-16, 20, and 23-25 have been cancelled, and new claims 55-61 have been added. Claim 55 is in independent form, with claims 56-61 depending therefrom.

Claims 13 through 16 had further limited the facial product of claim 11 to be a powder, a cream, a concealer, and a blemish control material, respectively. Claim 13 was amended herein to be in Markush form, and limit the facial product to be from the group consisting of those four products, permitting the cancelling of claims 14-16. Similarly, claims 19 and 20 further limited the nail product of claim 17 to be a nail polish and a hardener, respectively. Claim 19 was amended to be in Markush form and limit the nail product to be from the group consisting of those two products, permitting cancelling of claim 20. Also, claims 22 through 25 had further limited the facial product of claim 21 to be a powder, a cream, a concealer, and a blemish control material, respectively. Claim 22 was amended herein to be in Markush form, and limit the facial product to be from the group consisting of those four products, permitting the cancelling of claims 23-25.

### ***Claim Objections***

The Examiner has objected to claims 1-27, 29, 40-49, and 52-54 because of several informalities. The limitation of “a said rim” in claims 1 and 42 have been changed to read, “said rim.” Also, for both claims 1 and 42, the limitation of “essential oils and/or moisture” has been changed to read, “essential oils or moisture or both.” Finally, the limitation of claim 1- “said rod has a doe foot applicator”- has herein been changed to be “said rod having an applicator feature attached thereto.” This “applicator feature” is now further limited in claims 8, 11, 17, 27, 29, 40,

and 41. Therefore, the claims that the examiner found to be redundant or inconsistent (8, 11-20, 27, 29, 40, 41, 52-54) should now be acceptable.

***Claim rejections - 35 U.S.C. § 112***

The Examiner has rejected claims 1-27, 29, 40-49, and 52-54 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the examiner questioned the clarity of the description between the limitation “product” in lines 6-7 and the “essential oils and/or moisture” in lines 1-5. Claim 1 has therefore been modified to delete the “and/or” clause, and to further state that the spring is “to prevent essential oils or moisture or both *of said product* from escaping...” This should more clearly establish the relationship wherein the “essential oils” and “moisture” are components of the product. The same change was made with respect to objection of the “essential oils and/or moisture” of claim 42.

In claim 1, the examiner questioned the difference between the “rollerball applicator” in line 8 and the “roller ball” in line 14. The applicable language dealing with the “roller ball” in line 14 has been herein modified for greater clarity, and now reads, “...said receptacle having a rim extending from said neck with said rollerball being seated firmly against said rim...”

Regarding claim 42, the examiner questioned the inconsistent use of the “rollerball applicator” in line 5, and the “roller ball” in line 8. The relevant language has been modified to alleviate the inconsistency.

Applicant believes these claims rejected by the examiner are now in compliance with 35 U.S.C. § 112, second paragraph.

*Claim rejections - 35 U.S.C. § 103*

The Examiner has rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,626 to Bratby-Carey, in view of U.S. Patent No. 2,663,891 to Hanryon and U.S. Patent No. 6,276,856 to Pieper.

As stated in the previous amendment, but further clarified and amplified herein, Bratby-Carey explicitly discloses only a dual ended nail polish applicator, however, Bratby-Carey teaches the use of a check valve 38 to straighten bristles 42 of the brush assembly 32, which are not required by, or utilized in applicant's invention. Moreover, Bratby-Carey teaches the use of a spring loaded push valve 26 attached to a sponge pad 24 "for selectively dispensing the nail polish remover solvent from the internal reservoir 14" (Col. 3, lines 25-27). Conversely, applicant makes use of at least one rollerball, which, quite significantly, may dispense a fragrance, a facial product, a lip product, and a cosmetic serum, etc.

The examiner's maintenance of the obvious rejection, in view of Hanryon and Pieper, is respectfully traversed for the following reasons. Hanryon discloses a "Contact Delivery Device for Perfume," but teaches a complex manner that is distinctly different than, and furthermore not required by, applicant's invention. Hanryon teaches, at Col. 2, lines 24-28 and 33-36:

The plunger 11 is slidable on a bushing 12 which is formed at its bottom end with a flange 13 crimped in the plug member 2. Internally, the bushing is screw-threaded and a generally cylindrical wick 14 is threaded into the threaded bore of the bushing...when on the other hand pressure is applied to the ball 7 from outside, the ball will transmit said pressure through the ball bearing 8 to the plunger 11...

The noted elements are all taught by Hanryon but are not necessary to achieve the superior product dispensing capability achieved using applicant's rollerball applicator.

Applicant specifically states and claims that the rollerball arrangement disclosed herein is

nonetheless successful in “applying product onto the user,” while the spring serves to “prevent essential oils and/or moisture from unnecessarily escaping from the receptacle” (§ 41 of published application 2004/0234321). This is a distinctly different structural arrangement than the one taught by Hanryon, and is an arrangement which provides for superior results. Hanryon, maintains the position of “ball 7” through the combined use of ball bearings, an annular member, and a spring, stating at Col. 2, lines 13-18:

The ball 7 rests on an antifriction bearing means comprising a plurality of smaller balls 8 seated in bores 9 slightly larger in diameter than the balls 8 and formed in an annular member 10 which through its flat under-face rests upon plunger 11...

Conversely, applicant’s apparatus teaches use of “a spring that seats the ball firmly in the rim 24 of the receptacle” (§ 41 of published application 2004/0234321), which works in conjunction with the user applied force during dispensing to deflect, as required, when applying one of the many types of cosmetic substances cited herein.

Product application, using the roller ball arrangement taught by applicant, may be of very texturally dissimilar cosmetic products- perfume, as well as powders, creams, concealers, blemish control materials, lip products, and cosmetic serums- and is additionally provided for through operation whereby the ball is specifically designed to have a surface roughness corresponding with, or calibrated to be, in accordance with the consistency (viscosity) of the product to be dispensed. Applicant stated in the published application: “The surface of the roller ball be smooth or slightly roughened depending on the consistency of the product to be dispensed” (§ 45 of published application 2004/0234321). These unique elements and aspects of applicant’s invention have been highlighted in new independent claim 55, as well as dependent new claims 56-61.

Hanyron merely teaches an apparatus very narrowly tailored for the dispensing, with a

wick, of a single product- perfume. Hanryon uses an ordinary ball, and merely states in its description, at Col. 2, lines 12-13, that "The ball 7 is preferably formed of a suitable plastic material." There is no suggestion anywhere to completely reconstruct the art so as to result in applicant's dispenser, and to be able to achieve applicant's diverse and superior dispensing capability.

### ***Secondary Considerations***

"The 'secondary considerations' that the Supreme Court stated might be of possible utility in an obviousness determination, *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 466-467 (1966), also require a finding of nonobviousness if the matter be otherwise doubtful." *In re Sernaker*, 217 USPQ 1, 7. Applicant contends that the above arguments remove any doubt as to the non-obviousness of applicant's application under 35 U.S.C. § 103(a), however, applicant nonetheless further argues herein its basis for non-obviousness under the secondary considerations espoused by the courts, and supported by applicant's Rule 132 affidavit and exhibits.

The examiner has found applicant's affidavit insufficient to overcome the rejection of the claims, stating that "the commercial success must be due to claimed features," that "other equivalent language does not establish a nexus between the claimed invention and the commercial success," and that "the applicant must show that the claimed features were responsible for the commercial success."

Applicant wishes to direct the examiner's attention to the image in exhibit #1 that was supplied by applicant and was posted as of 04/03/2006 in the PTO Image File Wrapper history at page 11/30. It is shown, in part, below.



The image, one of many submitted, represents the product disclosed by applicant's invention herein, which is supplied to many major cosmetic companies, and serves to provide the nexus between the claimed invention and the commercial success. As described in the exhibit, the "KISS ME PINK ROLLERBALL" provides for the dispensing of "Our award-winning PINK fragrance and Pink Lip Shine together in a convenient rollerball..."

These two texturally distinct products are dispensed from rollerballs of the type disclosed herein. The product distinctiveness is shown in that one- the perfume- being a liquid-based product will generally have a viscosity not very different than water, which is  $8.90 \times 10^{-4}$  Pa·s or 0.890 cP (cps) at about 25 °C, whereas for a lip gloss, applicant refers the examiner to U.S. Patent No. 4,935,228 to Finkenaaur, which, in one of its examples (Col. 5 line 30), discloses a lip

gloss having viscosity in the range of 10-23 cps.

As stated by the Court of Appeals for the Federal Circuit, “to have true relevance to the issue of nonobviousness, that success must be shown to have in some way been due to the nature of the claimed invention, as opposed to other economic and commercial factors unrelated to the technical quality of the patented subject matter... Thus, a ‘nexus is required between the merits of the claimed invention and the evidence offered...’” *Cable Electric Products, Inc. v. Genmark, Inc.*, 226 USPQ 888.

Applicant submits that the ability to dispense such texturally different products, which is enabled through the unique features disclosed by applicant’s invention herein, particularly the rollerball with varying surface roughness, supplies the engine for its marketability, and is specifically that “technical quality” referred to by the Federal Circuit. The ability to dispense products having markedly different characteristics, especially its fluidity or viscosity, goes to the nature of the invention, and thus satisfies the nexus requirements cited in *Cable Electric Products*.

### **CONCLUSION**

For the foregoing reasons, applicant believes the claims are now in condition for allowance.

Respectfully submitted,



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